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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
CARTER et al.
Application No.: 10/719,066

Confirmation Number: 9145

Group Art Unit: 3738

Filed: November 24, 2003

Examiner: Stewart, Alvin J.

Title: STENT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed herewith, Applicants respectfully request review of the rejection of claims 1-39 under 35 U.S.C. § 103(a) over Mitchell et al. (U.S. Patent 6,214,037) in view of Zimmon (U.S. Patent 5,052,998) and Finney (U.S. Patent 4,307,723) .

Claims 1 and 27 each recite, *inter alia*, at least one conically tapered tip portion disposed at an end of the body.

The Examiner acknowledges that neither Mitchell et al. nor Zimmon disclose or suggest at least one conically tapered tip portion disposed at an end of the body, but alleges that Finney teaches a stent comprising a plurality of channels formed between two conically tapered tip portions disposed at each end of a body having an atraumatic tip. It is respectfully submitted that Finney do not disclose or suggest any conically tapered tip portion, and in fact teach away from such a feature.

As disclosed in column 4, lines 18-19, the stent 10 is provided with both ends 11 and 12 closed. The distal end 12 is clipped and the wire stylet 21 is introduced into the lumen 23 and passed through substantially the full length of the stent 10 to straighten out both hooks 13 and 14. Column 4, lines 22-26. As further disclosed in column 4, lines 43-45, the stent is of substantially uniform diameter (i.e. does not have a conically tapered tip portion) with both ends smoothly closed and without flanges or barbs or other protrusions.

As the last passage of Finney discussed above clearly indicates, Finney clearly teaches away from any use of a flange or barb, such as used by Zimmon. In other words, Finney clearly teaches away from any combination with Zimmon.


As neither Mitchell et al., Zimmon, or Finney discloses or suggests at least one conically tapered tip portion disposed at an end of the body, the combination fails to include all the claim limitations and fails to present a prima facie case of obviousness. See MPEP § 2143.

As Finney clearly teaches away from any combination with, at least, Zimmon, there is no teaching, suggestion, or motivation, either within the references themselves, or within the knowledge generally available to one of ordinary skill in the art, to combine the references in the manner proposed by the Examiner. Accordingly, the combination fails to present a *prima facie* case of obviousness.

Applicants appreciate the indication that claims 11, 16, 19, 20, 26 and 32 define patentable subject matter. However, in view of the above amendments and remarks, Applicants respectfully submit that all the claims are allowable and that the entire application is in condition for allowance.

Respectfully submitted,

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